D1 cncld.

an abutment portion disposed between the plug portion and the diode casing, the abutment portion projecting with respect to the plug portion in a direction radial to said axis, wherein the plug portion has a smaller radius than the abutment portion.

D2

18. (new). A plinth according to Claim 1, wherein the casing is metallic.

19. (new). An assembly according to Claim 5, wherein the casing is metallic.

REMARKS

Reconsideration of the above-identified application in view of the foregoing amendments and the following remarks is respectfully requested.

A. Explanation of Amendments

Claim 1 was amended to clarify that "an abutment portion disposed between the plug portion and the diode casing, the abutment portion." Support for this amendment is found in Figure 1 and elsewhere throughout the specification.

Applicant also has added two new claims, numbers 18 and 19, which recite that "the [diode] casing is metallic." Support for these claims is found in the specification at page 4 and elsewhere.

No new matter is added by these amendments and new claims.

B. Prior Rejection of Claims 1-17 Is Traversed

In the March 8, 2001 office action, claims 1 through 17 were rejected under 35 U.S.C. § 103(a). As best understood, the Examiner's rejection relied on the combination of four separate references: (1) U.S. Patent No. 5,828,564 to Mori et al. ("Mori"), (2) U.S. Patent No. 5,982,062 to Gautier ("Gautier"), (3) U.S. Patent No. 5,883,450 to Abadia et al. ("Abadia") and

(4) U.S. Patent No. 4,472,649 to Namba et al. ("Namba"). That rejection properly cannot be made against claims 1-17 as explained below.

1. Gautier And Abadia Are, At Best, § 102(e) References And May Not Used In A § 103 Rejection

The prior rejection was in error because it failed to comply with 35 U.S.C. § 103(c). Under that provision of the patent statute it is improper to lodge a rejection under 35 U.S.C. § 103(a) using so-called § 102(e), (f) or (g) prior art "where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person."

The present application claims priority to a prior French application filed September 8, 1997. The Gautier and Abadia references cited by the Examiner were issued after that date (November 9, 1999 and March 16, 1999, respectively). At best, these are references under 35 U.S.C. § 102(e). On their face, these patents are assigned to "Valeo Equipments Electriques Moteur."

By an assignment dated September 7, 1998, the present application was also assigned to "Valeo Equipments Electriques Moteur."

Accordingly, pursuant to 35 U.S.C. § 103(c) Applicant respectfully asserts that a rejection under 35 U.S.C. § 103(a) is inappropriate here where it relies on the Gautier and Abadia references.

2. A Rejection Under § 103 Using Mori And Namba Without Gautier And Abadia Is Improper Because All Elements Cannot Be Shown

Applicant's claim 1 recites:

> 1. A plinth for supporting a diode having a casing that is welded on the plinth, the plinth including
>
> a plug portion adapted to be force-fitted into an aperture and defining an axis of the plinth, and
>
> an abutment portion disposed between the plug portion and the diode casing, the abutment portion projecting with respect to the plug portion in a direction radial to said axis, wherein the plug portion has a smaller radius than the abutment portion.

A rejection under 35 U.S.C. § 103(a) requires a showing that all of the claim elements are shown in the cited references. MPEP § 2143.03. As explained below, this showing cannot be made here without Gautier and Abadia.

a. *Mori Is Deficient In At Least Four Respects*

Mori is directed to rectifier heat dissipation device having a rectifying diode 231 with an anode electrode 231a and an unshown diode chip in a mold resin 231b. Col. 3, lines 22-34. The chip is molded into the mold resin.

A metal base of copper 231c had the mold resin 231b on one of its surfaces. Col. 3, lines 35-36. The metal base is depicted as having a flat principal surface upon which the mold resin rests. See Figure 1. The metal base 231c is press fitted into a socket section 303a of a heat sink. Col. 3, lines 45-46.

With regard to claim 1, it was previously conceded that Mori does not teach, disclose or suggest: (1) "the diode casing welded to the plinth," (2) "the diode positioned within

a cavity" and (3) "the abutment portion having a smaller radius than the plug portion." 3/8/01 Office Action at p. 3.

A fourth deficiency in Mori is that there is no disclosure of "an abutment portion disposed between the plug portion and the diode casing." In the prior office action, it was alleged that "an abutment portion which projects radially inward from the plug portion was shown in Mori. See 3/8/01 Office Action at p. 3. No reference was made in that office action to a numbered element of Mori.

Moreover, in that office action, the Examiner alleged that Mori's plinth 231d corresponded with the "plug portion" of Applicant's claim 1. As shown in Mori's Figure 1, above that feature is the rectifying diode 231 and its mold resin 231b. Accordingly, Mori also fails to teach, disclose or suggest "an abutment portion disposed between the plug portion and the diode casing" as recited in claim 1.

b. Namba Does Not Alleviate The Deficiencies

Namba is directed to a brushless rotary machine, which in Figure 11 (to which the Examiner referred) shows coolers 68 positioned in through-holes 76. Col. 5, lines 57-59. Insulating sleeves 84 are interposed between the coolers and the holes. Col. 5, lines 60-61.

Each of the coolers 68 includes a main frame 68a with an outer peripheral surface mounted to the insulating plate 66, and a plurality of fins 68b disposed on both sides of the main frame 68a. The pair of rectifier elements 70a and 70b are fixed on the inner surface of the main frame 68a.

As to Mori's first deficiency, there is certainly no discussion of welding anywhere in Namba and the prior office action was unclear what in Namba was alleged to correspond with Applicant's diode casing.

As to Mori's second deficiency, Namba's Figure 11 that is relied upon in the prior office action apparently shows a flat surface. Thus, Namba also does not teach, disclose or suggest the diode positioned within a cavity.

3. *There Is No Motivation To Combine Namba's Alleged "Abutment Portion" and "Plug Portion" with Mori's Device*

Further, to the extent that the Examiner alleges that Namba alleviates Mori's third and fourth deficiencies (i.e., shows an "abutment portion having a smaller radius than the plug portion" and shows "an abutment portion disposed between the plug portion and the diode casing"), there is no proper motivation to modify the references and the rejection cannot be made. MPEP § 2143.01. In the March 8, 2001 Office Action, the Examiner alleged that one would use Namba's abutment portion "to help secure the plinth in the hole." 3/8/01 Office Action at p. 4. Respectfully, this allegation is incorrect.

Mori discloses a structure that includes a rectifying diode 231 having a metal base of copper 231c. Col. 3, lines 35-36 and Figure 1. According to Mori, the metal base 231c is press fitted into a socket section 303a of a heat sink. Col. 3, lines 45-46. Thus, in Mori's device, the metal base secures the plinth in the hole. Mori's disclosure would lead one of skill in the art to not believe that a further feature was necessary to secure the plinth, contrary to the allegation in the prior office action.

Namba's disclosure concerning figure 11 also does not provide motivation for this structure. See Col. 5, lines 57 – Col. 6, line 9.

Thus, separate and apart form Applicant's disclosure there is no motivation to modify the structure of Mori's device to include the abutment portion allegedly disclosed by Namba. Because there is no proper motivation to combine the cited references, a rejection under 35 U.S.C. § 103 cannot stand against Applicant's claims.

C. New Claims 18 And 19 Are Patentably Distinct

New claims 18 and 19 are patentably distinct from the cited references for at least similar reasons as claims 1-17. These claims are distinguished from the cited references for a further reason. Specifically, the Examiner has alleged that Mori's mold resin 231b corresponds to Applicant's diode casing. That is clearly not a "metallic" casing as recited in claims 18 and 19. None of the other references alleviate this shortcoming of Mori.

CONCLUSION

For the above-stated reasons, this application is respectfully asserted to be in condition for allowance. The Applicant respectfully requests an early and favorable examination on the merits. In the event that a telephone conference would facilitate the examination of this application in any way, the Examiner is invited to contact the undersigned at the number provided.

Respectfully submitted,

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Dated: September 21, 2001

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APPENDIX
(Claims with interlineated changes shown)

1. (Thrice Amended) A plinth for supporting a diode having a casing that is welded on the plinth, the plinth including

a plug portion adapted to be force-fitted into an aperture and defining an axis of the plinth, and

an abutment portion disposed between the plug portion and the diode casing, the abutment portion projecting with respect to the plug portion in a direction radial to said axis, wherein the plug portion has a smaller radius than the abutment portion.

--18. (new). A plinth according to Claim 1, wherein the casing is metallic.--

--19. (new). An assembly according to Claim 5, wherein the casing is metallic.--

5. (Twice Amended) An assembly comprising:

a diode having a casing and

a plinth [according to Claim 1, said casing being fixed to the plinth] welded to the diode casing, the plinth comprising (a) a plug portion adapted to be force-fitted into an aperture and defining an axis of the plinth, and (b) an abutment portion projecting with respect to the plug portion in a direction radial to said axis,

wherein the plug portion has a smaller radius than the abutment portion.

17. (Amended) A motor vehicle alternator comprising:

[the] a plinth [according to claim 1] adapted to support a diode having a casing, wherein the diode casing is welded to the plinth, the plinth comprising (a) a plug portion adapted to be force-fitted into an aperture and defining an axis of the plinth, and (b) an abutment portion projecting with respect to the plug portion in a direction radial to said axis,

wherein the plug portion has a smaller radius than the abutment portion and a diode affixed to the plinth.